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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,944	07/31/1997	FRANZINE SMITH	089166/0107	3007

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EXAMINER

FOX, DAVID T

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/903,944

Applicant(s)

SMITH ET AL.

Examiner

David T. Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 73-96, 100 and 112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 73-96, 100 and 112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The outstanding rejections have been WITHDRAWN in view of the Board Decision of 20 May 2005. However, the prior indication that the claims were free of the prior art is hereby WITHDRAWN in view of the newly discovered art cited below. The delay in prosecution is regretted.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 87-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Dependent claims are included in all rejections.

Claim 87 is indefinite for failing to further limit claim 86 from which it depends. Claim 86 is drawn to a plant containing a chitinase gene and a second gene, while claim 87 is drawn to a plant containing a magainin 2 gene and a second gene. Amendment of claim 87 to depend upon claim 85 would obviate this rejection.

Claim 88 is indefinite for failing to further limit claim 86 from which it depends, since claim 88 is directed to an ethylene insensitivity gene. Amendment of claim 88 to depend upon claim 73 would obviate this rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 73-96, 100 and 112 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 6,235,973, effectively filed concurrently with the instant application. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the methods of obtaining transformed poinsettia tissue as claimed in the copending application, to obtain the transformed poinsettia plants comprising tissue as instantly claimed. Choice of known foreign gene would have been the optimization of process parameters, particularly in light of the Board Decision of 20 May 2005, pages 7-10. The claims are coextensive.

Claims 73-75, 85, 95-96 and 100 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US 5,945,579 filed 05 October 1995).

The claims are broadly drawn to a poinsettia plant transformed with any gene, including the phyA gene under the control of the CaMV 35S promoter conferring modified plant habit, and optionally containing a second transgene, and wherein the plant is fertile.

Smith teaches poinsettia plants transformed with the phyA gene under the control of the CaMV 35S promoter, and optionally containing an nptII gene conferring kanamycin resistance (see, e.g., column 3, lines 39-45; column 4, lines 50-59; column

9, lines 10-31; claims 1, 7 and 11). Fertility would have been an inherent property of the plants taught by the reference.

Claims 73-96, 100 and 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 5,945,579 filed 05 October 1995).

The claims are broadly drawn to poinsettia plants transformed with particular marker genes, promoters, disease-resistance or pest resistance genes, or genes conferring other agronomic properties.

Smith teaches transformed poinsettia plants containing two genes and the CaMV 35S promoter, as discussed above, but does not explicitly teach the use of other agronomically desirable genes, or inducible or tissue-specific promoters. Smith does suggest the use of other inducible or tissue-specific promoters, including those induced by disease (see, e.g., column 6, line 50 through column 7, line 6).

It would have been obvious to one of ordinary skill in the art to utilize the transformed poinsettia plants containing two genes, at least one of which confers an agronomically desirable trait, as taught by Smith; and to modify that by incorporating other known genes conferring agronomically desirable traits and other promoters useful for expressing these genes in particular plant tissues of interest. Given the Board Decision of 20 May 2005, the choice of known agronomically desirable gene and promoter would have been the optimization of process parameters.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is 571-272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 9, 2005

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", written over the printed name and title.